

Application No.: 09/761,797

Case No.: 55716US002

Remarks

Claims 1-20 are pending. Claims 1, 9, 12, and 18 have been amended to correct editorial matters and for greater precision in distinguishing the present invention from the cited art.

§ 103 Rejections

The Examiner has rejected claims 1-2, 6, and 9-11 under 35 USC § 103(a) as being unpatentable over Sundet (5,665,446) in view of Futhey (5,840,407).

Claim 1:

Claim 1 recites a method for decorating a substrate in which a decorative pattern is made by the steps of;

providing a kit including a laminate that is at least translucent comprising a cover sheet and a layer of adhesive adhered to one surface of the cover sheet; including a predetermined printed design; and including loose pieces of optical film that have peripheral shapes corresponding to at least parts of the printed design, each of which pieces of optical film has a layer of adhesive along one surface and has grooves or other structure along an opposite surface so that the pieces visually simulate decorative structures;

placing the pieces of optical film over portions of the design corresponding to their shapes with the structured surfaces of the pieces of film along a common plane; and adhering the structured surfaces of the pieces of film to the layer of adhesive on the laminate;

whereupon the decorative pattern can be applied to a substrate by subsequent method steps similar to those described in Sundet.

The Examiner has stated "the Sundet reference teaches the steps of providing a kit, placing the optical film pieces on a common plane, adhering the pieces onto the laminate cover, placing the formed composite onto a substrate, and pressing the air out from between the substrate and removing the laminate cover."

We question whether any structure described in Sundet would be considered a kit. In any event, the structure described in Sundet is not a kit including either a predetermined printed

Application No.: 09/761,797

Case No.: 55716US002

design, or loose pieces of optical film as are claimed in claim 1. Also, there is no suggestion in Sundet of the method step recited in claim 1 of placing the pieces of optical film over portions of the design corresponding to their shapes with the structured surfaces of the pieces of film along a common plane.

Instead, Sundet forms graphics by cutting through a decorative polymeric film and a layer of aggressive pressure sensitive adhesive that adheres that film to a low-adhesion carrier web without cutting through the carrier web, and then peeling the away the adhesive-bearing weed between the graphics thus cut from the film (see Sundet, column 2, lines 39-47).

The Examiner has acknowledged at least some of these differences between the present invention as claimed in claim 1 and the structure described in Sundet by citing Futhey.

While Futhey describes an optical film of the type used in the present invention, there is no teaching or suggestion in Futhey to replace the polymeric film of Sundet with optical film, or to use such optical film to decorate a substrate by a method including the steps of providing a predetermined printed design and loose pieces of such optical film that have peripheral shapes corresponding to at least parts of the printed design, and then placing the pieces of optical film over portions of the design corresponding to their shapes with the structured surfaces of the pieces of film along a common plane. These steps claimed in claim 1 patentably distinguish the method claimed in claim 1 from Sundet and Futhey.

Claims 2 through 8 are dependent on claim 1 and are thus allowable for the reasons given above with respect to claim 1. Additionally, these dependent claims recite additional method steps that are not shown or suggested by the cited art in the claimed combination. For example:

Claim 3 recites that the predetermined printed design is printed on the laminate, and that the step of placing the pieces of optical film over portions of the design corresponding to their shapes comprises the step of pressing the structured surfaces of the pieces of film against the layer of adhesive on the laminate;

Claim 5 recites that the predetermined printed design is printed on a template provided in the kit, and the method includes the step of positioning the template along the side of the laminate opposite the layer of adhesive during the steps of placing the pieces of optical film over

Application No.: 09/761,797

Case No.: 55716US002

portions of the design corresponding to their shapes and adhering the structured surfaces of the pieces of film to the layer of adhesive on the laminate;

Claim 6 recites that the predetermined printed design is printed on a layer of liner material that is at least translucent and has a release surface shaped or treated to provide easy release from the layers of adhesive on the pieces of optical film, the step of placing the pieces of optical film over portions of the design corresponding to their shapes comprises the step of pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material, the step of adhering the structured surfaces of the pieces of film to the layer of adhesive on the laminate comprises the step of pressing the layer of adhesive on the laminate against the structured surfaces on the pieces of film adhered to the liner material, and the method further includes the subsequent step of peeling away the liner material before the step of placing the pieces of optical film adhered to the layer of adhesive on the laminate at a desired location on the substrate;

Claim 7 recites that the predetermined printed design is printed on a template provided in the kit, a layer of at least translucent liner material having a release surface shaped or treated to provide easy release from the layers of adhesive on the pieces of optical film is provided in the kit, the method includes the step of positioning the template along the side of the layer of liner material opposite its release surface, and the step of placing the pieces of optical film over portions of the design corresponding to their shapes comprises the step of pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material, the step of adhering the structured surfaces of the pieces of film to the layer of adhesive on the laminate comprises the step of pressing the layer of adhesive on the laminate against the structured surfaces on the pieces of film adhered to the liner material, and the method further includes the subsequent step of peeling away the liner material before the step of placing the pieces of optical film adhered to the layer of adhesive on the laminate at a desired location on the substrate; and

Claim 8 recites that at least one of the pieces of optical film has a peripheral shape that corresponds to only a part of the printed design, and the method further includes the step of cutting said at least one of the pieces of optical film.

Application No.: 09/761,797

Case No.: 55716US002

Against dependent claims 3-5 and 7-8 dependent on claim 1 the Examiner cited McNaul (5,225,260) in addition to Sundet and Futhey because the combination of Sundet and Futhey “fails to teach that the kit comprises a predetermined printed design”. The Examiner stated that “McNaul teaches a laminate comprising an application tape (24) having printed design (50) on one of the surface thereof. McNaul teaches the advantage of the presence of the print that provides for alignment of the sign components”.

The lines (51) and (52) of the design (50) described by McNaul, however, are used only for the purpose of aligning an already formed sign on a substrate such as on the sidewall of a trailer (see column 10, lines 18-38 of McNaul), and have nothing to do with forming a design using pieces of optical film as does the predetermined printed design used in the method according to the present invention. Thus there is no teaching in suggestion in McNaul that would make obvious the present invention as claimed in claims 3- 5 or 7-8 or in claim 1 on which those claims are dependent.

Independent Claim 9:

Claim 9 recites a method for decorating a substrate in which a decorative pattern is made by the steps of;

- providing a kit including a laminate that is at least translucent comprising a cover sheet and a layer of pressure-sensitive adhesive adhered to one surface of the cover sheet; including loose pieces of optical film, each of which pieces of optical film has a layer of pressure-sensitive adhesive along one surface, and has grooves or other structure along an opposite surface so that the pieces visually simulate decorative glass or glass related structures; and including a layer of liner material having a release surface shaped or treated to provide easy release from the layers of adhesive on the pieces of optical film;

- pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material to provide a decorative pattern;

- pressing the layer of pressure-sensitive adhesive on the laminate against the structured surfaces on the pieces of film adhered to the liner material; and

- peeling away the liner material;

Application No.: 09/761,797

Case No.: 55716US002

whereupon the decorative pattern can be applied to a substrate by subsequent method steps similar to those described in Sundet.

As noted above, the structure described in Sundet is not a kit including loose pieces of optical film as are claimed in claim 9. Also, there is no suggestion in Sundet of the method steps recited in claim 9 of pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material to provide a decorative pattern; pressing the layer of pressure-sensitive adhesive on the laminate against the structured surfaces on the pieces of film adhered to the liner material; and peeling away the liner material.

Instead, as noted above, Sundet forms graphics by cutting through a decorative polymeric film and a layer of aggressive pressure sensitive adhesive that adheres that film to a low-adhesion carrier web without cutting through the carrier web, and then peeling the away the adhesive-bearing weed between the graphics thus cut from the film (see Sundet, column 2, lines 39-47).

The Examiner has acknowledged at least some of these differences between the present invention as claimed in claim 9 and the structure described in Sundet by citing Futhey.

While Futhey describes an optical film of the type used in the present invention, there is no teaching or suggestion in Futhey to replace the polymeric film of Sundet with optical film, or to use such optical film to form a decorative pattern using the steps noted above

Those steps claimed in claim 9 patentably distinguish the method claimed in claim 9 from Sundet and Futhey.

Claims 10 and 11 are dependent on claim 9 and are thus allowable for the reasons given above with respect to claim 9. Additionally, these dependent claims recite additional method steps that are not shown or suggested by the cited art. Claim 10 recites that a predetermined design is printed on the layer of liner material, and that the step of pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material to provide a decorative pattern comprises placing the pieces of optical film over portions of the design corresponding to the shapes of the pieces of optical film; whereas claim 11 recites that a predetermined design is printed on a template provided in the kit, and that the step of pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material to

Application No.: 09/761,797

Case No.: 55716US002

provide a decorative pattern includes the steps of positioning the template along the side of the layer of liner material opposite its release surface, and placing the pieces of optical film over portions of the design corresponding to the shapes of the pieces of optical film. As noted above there is no teaching or suggestion in any of the cited references to provide and use a printed predetermined design to form a decorative design in a method such as that claimed in claim 9.

Independent Claim 12

Claim 12 claims a kit for decorating a substrate, which kit comprises a laminate that is at least translucent comprising a cover sheet and a layer of adhesive adhered to one surface of the cover sheet; a predetermined printed design; and loose pieces of optical film that have peripheral shapes corresponding to at least parts of the printed design, each of which pieces of optical film has a layer of adhesive along one surface and has grooves along an opposite surface so that the pieces visually simulate decorative structures. The kit can be used to make a predetermined design using method steps such as those recited in claim 1.

The Examiner has rejected claims 12-17 under 35 USC § 103(a) as being unpatentable over Sundet in view of Futhey and McNaul.

As discussed above, however, the structure described in Sundet is not a kit including either a predetermined printed design, or loose pieces of optical film as are claimed in claim 12. While Futhey describes an optical film of the type used in the present invention, there is no teaching or suggestion in Futhey to replace the polymeric film of Sundet with optical film. The lines (51) and (52) of the design (50) described by McNaul are used only for the purpose of aligning an already formed sign on a substrate such as on the sidewall of a trailer (see column 10, lines 18-38 of McNaul), and have nothing to do with forming a design using pieces of optical film as can be done with the predetermined printed design included in the kit according to the present invention that is claimed in claim 12. Thus there are no teachings or suggestions in Sundet, Futhey or McNaul that would make obvious the kit according to the present invention that is claimed in claim 12.

Claims 13 through 17 are dependent on claim 1 and are thus allowable for the reasons given above with respect to claim 12. Additionally, these dependent claims recite additional

Application No.: 09/761,797

Case No.: 55716US002

structural features that are not shown or suggested by the cited art in the claimed combination.

For example:

Claim 13 recites that the predetermined printed design is printed on the laminate so that the pieces of optical film can be placed over portions of the design corresponding to their shapes by pressing the structured surfaces of the pieces of film against the layer of adhesive on the laminate;

Claim 15 recites that the kit includes a template on which the predetermined printed design is printed;

Claim 16 recites that the predetermined printed design is printed on a layer of liner material having a release surface shaped or treated to provide easy release from the layers of adhesive on the pieces of optical film; and

Claim 17 recites that the kit includes a layer of liner material that is at least translucent having a release surface shaped or treated to provide easy release from the layers of adhesive on the pieces of optical film, and a template with the predetermined printed design being printed on the template.

The Examiner has rejected claims 18 and 19 under 35 USC § 103(a) as being unpatentable over Sundet in view of Futhy.

Claim 18:

Independent claim 18 claims a kit for decorating a substrate that comprises a laminate that is at least translucent comprising a cover sheet and a layer of pressure-sensitive adhesive adhered to one surface of the cover sheet with the cover sheet and layer of adhesive being vented; loose pieces of optical film, each of which pieces of optical film has a layer of pressure-sensitive adhesive along one surface, and grooves or other structure along an opposite surface so that the pieces visually simulate decorative glass or glass related structures; and a layer of liner material having a release surface shaped or treated to provide easy release from the layers of adhesive on the pieces of optical film. The claimed kit affords pressing the layers of adhesive on the pieces of optical film against the release surface on the liner material to provide a decorative pattern; pressing the layer of adhesive on the laminate against the structured surfaces on the pieces of film adhered to the liner material; peeling away the liner material; placing the pieces of optical film

Application No.: 09/761,797

Case No.: 55716US002

adhered to the layer of adhesive on the laminate at a desired location on the substrate; pressing out air from between the substrate and the pieces of optical film adhered to the layer of adhesive on the laminate; and removing the laminate to leave the pieces of optical film adhered to the substrate in the decorative pattern.

As discussed above, however, the structure described in Sundet is not a kit including a laminate and a layer of liner material together with loose pieces of optical film as are claimed in claim 18, and while Futhey describes an optical film of the type used in the present invention, there is no teaching or suggestion in Futhey to replace the polymeric film of Sundet with optical film.

Also, there is no teaching or suggestion in either Sundet or Futhey to provide a predetermined design printed on the layer of liner material as is claimed in dependent claim 19 to afford placing the pieces of optical film over portions of the design corresponding to the shapes of the pieces of optical film; and no teaching or suggestion in either Sundet or Futhey or McNaull to provide a template and a predetermined design printed on the template as is claimed in claim 20 dependent on claim 18 to afford positioning the template along the side of the layer of liner material opposite its release surface, and placing the pieces of optical film over portions of the design corresponding to the shapes of the pieces of optical film.

Reconsideration in view of the above amendments and comments and allowance of all of the claims now in this application are respectfully requested.

Respectfully submitted,

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Date

By: W³ L. Huebsch
William L. Huebsch, Reg. No.: 25,990
Telephone No.: (651) 733-2835

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833

W1.H/spg